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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,351	12/04/2003	Randy Miller	1663-6	8612

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EXAMINER	
HARPER, TRAMAR YONG	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,351	MILLER, RANDY	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/18/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 12/18/06. The arguments set forth in the response are addressed herein below. Claims 1-26 are pending and Claims 1-26 have been amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Stand alone" was not disclosed in the Specification. Examiner contends that in regards to stand-alone there is no relevant teaching or suggestion that the gaming device is stand-alone or strictly single player.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Progressive Jackpot" was not disclosed in the

Specification. The Specification does not teach the use of a progressive jackpot or a method of playing with multiple players.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker et al (US 2002/0042296).

Claims 1 and 12-15: Walker discloses a slot machine (includes video poker, video blackjack, and keno machines (¶36)), in which a player places a wager to initiate a game of video poker (¶ 84). If the final hand matches any of the bonus hands indicated in the bonus database and displayed on the gaming apparatus a bonus is initiated (¶ 86-87; Fig. 5). The bonus initiating hands are also amongst the bonus hands needed to be obtained within the bonus (¶ 86-89). If a bonus initiating hand is obtained bonus play timers are initiated and player(s) must obtain a predetermined number of bonus hands within the predetermined time period. Upon the bonus winning outcome a player is awarded a bonus payout (¶ 92). Walker discloses that the a single player that obtains all of the hands necessary to fulfill the bonus conditions receives the only bonus payout resulting from meeting the bonus conditions (¶ 64). This is interpreted as a player can initiate the bonus and that player can receives the enhanced payout if the player fulfills

the bonus conditions. Although in team play, Walker discloses that in the event that the player does not choose to play in team play the player may engage in stand-alone play at the same machine (¶ 55). Therefore, it is interpreted that, although not explicitly stated, Walker implies that in stand-alone mode a single player can play the bonus, as described above. However, in the alternative one of ordinary skill in the art at the time of the invention would be motivated to modify the gaming device of Walker such that the bonus is playable in stand-alone mode, for providing a stand-alone bonus game for players that do not wish to participate in team play, as suggested by Walker (see above).

Claims 2-7: Walker's video poker game comprises of visual indicators of the bonus payout and the bonus timers. Once the bonus game is initiated the indicators are displayed and remain active until the bonus is won or there is no bonus time remaining (¶ 89, 92; Figs. 5 & 11C).

Claims 8-11: If the final hand matches any of the bonus hands indicated in the bonus database and displayed on the gaming apparatus a bonus is initiated (¶ 87; Fig. 5). If a bonus initiating hand is obtained bonus play timers are initiated. In the embodiment anyone of the bonus initiating hands can initiate the bonus timer, but modifications such as limiting the activation of the timer to only one bonus hand is within the scope of the above teachings. Figure 5 illustrates a plurality of bonus timers with different values (¶ 89).

Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Walker (US 2002/0042296) in view of the Stupak (US 5,851,147).

Claims 16-17: Walker teaches all the limitations as taught above, except the use of a first payout display. Walker discloses that the first payout is determined by using a payout table derived from the payout database (Col. 12-49-51). Also, Fig. 5 illustrates the display of the enhanced payout table, which is also cleared when a bonus is not commencing. It is known in the art to display a payout table in video poker. Stupak discloses a gaming apparatus that display payouts from 1-4 coins played and a jackpot or enhanced payout with a max of 5 coins wagered (Fig. 1, Col. 7:15-21). It would have been obvious of one of ordinary skill at the time of invention to modify the gaming apparatus such that the base payout display is displayed as well as the bonus payout display, as taught by Stupak. Providing a payout table give the player the feeling of winning potential earnings prior to playing the game.

Claims 18-19, 24-26: It is conventional in the art that players receive a certain percentage or multiple earnings based on the amount waged and/or the profit gained by the sponsor. Walker does not disclose that the potential bonus earnings are 25,000, 100,000, 250,000, or 1,000,000 times the amount wagered. Stupak discloses a video poker game where the earnings are more than 250,000 times the amount wagered (Fig. 6). It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Walker's bonus such that the potential bonus winnings at least 250,000 times the wager, as disclosed by Stupak. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Walker's invention, as stated above, because Applicant has not

disclosed that such a modification provides an advantage, is used for a particular purpose, or solves a stated problem.

Therefore, it would have been prima facie obvious to modify Walker to obtain the invention as specified in Claims 18-19, 24-26 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Walker.

Claim 20: Walker discloses linked gaming machines with progressive jackpots (¶ 7).

Claim 21: Fig. 5 illustrates the use of the decrementing timer (¶ 89).

Claims 22-23: Stupak's video poker game displays at least 4 enhanced payouts and a payout for identical cards (Fig. 1).

Response to Arguments

Applicant's arguments with respect to Claims 1-26 have been considered but are moot in view of the new ground(s) of rejection. The Examiner respectfully reminds the applicant that the 35 U.S.C. 112, first paragraph rejection in regards to Claim 20 wasn't addressed and appropriate correction is required.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneider et al (US 5,639,088) discloses a video poker game wherein a player obtains an initial winning outcome and has a certain amount of plays to achieve additional equivalent occurrences of the initial winning outcome.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH

3/21/07